

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on October 25, 2006, the Examiner objected to claims 17-20; claims 1-4, 8, 9, 10 and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fromm (US 5,435,240) in view of Skonecki (US 5,305,550), Reinhardt et al (US 4,957,787), Hirata (JP 59-016801, Roulleau (US 5,142,976) and Carroll (US 5,366,192); claims 5-7 were rejected under 35 U.S.C § 103(a) as being unpatentable over Fromm (US 5,435,240) in view of Skonecki (US 5,305,550), Reinhardt et al (US 4,957,787), Hirata (JP 59-016801, Roulleau (US 5,142,976) and Carroll (US 5,366,192); claims 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Skonecki (US 5,305,550) in view of Carroll (US 5,366,192); claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Skonecki (US 5,305,550) in view of Carroll (US 5,366,192), as applied to claim 16 above, and further in view of Lampinski (US 6,314,880).

Claim Objections

Applicant has amended claims 17-20 in order to ameliorate the claim objections in the pending office action. Accordingly, Applicant requests that the objections be lifted at this time.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-4, 8, 9, 10, 16, 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,423,240 to Fromm in view of U.S. Pat. No. 5,305,550 to Skonecki, U.S. Pat. No. 4,957,787 to Reinhardt, Japanese Pat. No. 59-016801 to Hirata and U.S. Pat. No. 5,142,976 to Roulleau. In addition, the Examiner rejected claims 5-7 and 19-20 under Section 103(a) as being unpatentable over Fromm in view of Skonecki, Reinhardt, Hirata and Roulleau in further view of U.S. Pat. No. 6,314,880 to Lampinski.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

There Is No Suggestion To Combine In The Prior Art

There is no suggestion in the art to combine and modify the references as cited by the Examiner. Fromm discloses a children's pad printing kit to be utilized on paper, plastic, ceramics, leather and fabric. No mention is made of flowers. Acknowledging this fact, the pending action cites Skonecki and several other supportive documents (i.e., Roulleau, Lampinski and Reinhardt). Skonecki is the only application that teaches putting an image on the leaf or petal of a flower. As taught in Skonecki, the process is not accomplished by utilizing a pad printing kit. The technology taught and utilized in Fromm (a deformable rubber like transfer pad) would destroy the invention as described by Skonecki, which is a process of drawing on the petals using a pen. The teachings of Skonecki acknowledge directly the difficulties of printing on a petal or leaf while preventing damage to the petal itself. Col. 2 lns. 1-18. Accordingly, the robust and repeatable method taught by Fromm would damage Skonecki's flowers.

Likewise, Reinhardt is directed at printing on artificial flowers, which are substantially more robust than live flowers. Roulleau teaches a method for printing on the hard calcified surface of an egg. Carroll teaches a method of putting a card in front of a flower, and Lapinski teaches a method for printing on golf balls. Accordingly, Applicant asserts that the combination of Fromm, Skonecki and other supportive art is inappropriate, and should not form the basis for rejecting the present claim set under 35 U.S.C. § 103(a).

The Cited References Do Not Teach All Of The Limitations Claimed

The cited references do not teach every aspect of the claimed invention. In particular, independent claim 1 recites a method for providing a repeatable pad-printed image on a flower, the method comprising the steps for: producing a group of flowers, each flower having a stem and one or more petals, wherein said one or more petal(s) is free of an etched or cut image comprising: creating a repeatable, identical, pad-printed image provided on said petal that is free from an etched or cut image, said image selected from the group of: a communication from a sender of the group of flowers to an individual recipient of the group of flowers; a personalized communication to the individual recipient of the group of flowers; a generic message to recipients in general; and a commemoration of an event. Independent claims 16 and 21 include similar limitations, and such limitations are supported by the disclosure as originally filed.

Fromm does not teach the method and system for providing an image on a flower, as Applicants now claim in independent claims 1, 16, and 21 respectively. Rather, Fromm discloses that his Children's Pad Printing Kit may print on the following surfaces: papers, plastics, ceramics, skin, leather and fabric, but makes no mention of flowers. See Fromm, Col. 5, lns. 2-5. In contrast, Applicants disclose that the methods and processes of the present invention are "particularly useful in the floricultural industry." See page 4, lines 22-23 (emphasis added). In addition, Applicants disclose in many different places that their systems and processes provide images on flowers. See e.g., page 2, line 7; page 4, lines 3-7, 14-15, 18-21; page 7, lines 3-5, 7-8; page 9, lines 17-20; page 12, lines 18-20; page 13, lines 2-5.

Skonecki does not teach the repeatable, pad printed limitations of amended claims 1 and 16, because traditional pad printing methods would destroy the surface of the flower. Accordingly, Skonecki discloses a method of delicately writing on the petals of a flower with a

particular pen. Fromm's Children's Pad Printing Kit is not meant for use on delicate surfaces such as flowers and as such, one skilled in the art would not think to combine it with Skonecki. According to Fromm's teachings, the Children's Pad Printing Kit is meant to be used on durable surfaces that allow re-use after washing the surface with a sponge. Col. 4, ln. 67 – Col. 5, ln. 5. Fromm specifically mentions that image removal is done without damage to the material of the surface and then goes on to include a list of such durable surfaces. Col. 4, ln. 67 – Col. 5, ln. 5. Notably absent from this list are flowers or any other delicate surfaces that could not withstand the rigor of washing for re-use. Thus, Fromm, in via of Skonecki, fails to teach all of the limitations found in the claims and it is evident that there is no motivation to combine Fromm's Children's Pad Printing Kit with Skonecki's Personalized Flower to generate the present invention's method and system for providing a repeatable, pad-printed image on a flower.

Rouleau does not teach pad printing on an image as broad as a "delicate organic product." Rouleau specifically teaches printing on "uncooked poultry eggs." (Col. 3, 17-33). The claims and specification are clear on this point. (*Id.*) And, Rouleau teaches of printing in a way different than disclosed in Applicants' specification; on the egg by a machine comprising two angled facets. Applicants teach of printing on a petal that leaves a surface-only image on the petal. Second, "in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established." In re Brown, 459 F.2d 531, 535, (CCPA 1972). The Federal Circuit held that only when the prior art discloses a product, which reasonably appears to be either identical with or only slightly different than a product claimed in a product -by-process claim is a section 103 rejection fair and acceptable. *Id.* The product described in Applicants' claimed invention as amended is neither identical nor only slightly different than the products disclosed in the prior art

references. In particular, Roulleau discloses *eggs* with images on them, while. Applicants' claimed invention provides images on *petals* of flowers that are free from *etching or cuts*. Thus, the claimed invention is further rendered unobvious in light of the references.


For at least this reason, Applicant respectfully submits that the prior art does not explicitly or impliedly teach every aspect of the invention as claimed in the independent base claims. In addition, the dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited art does not teach every aspect of the claims as provided herein and therefore does not render the claims obvious as provided herein.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,


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